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EXAMINER

EHICHIOYA, FRED I

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/033,225
Filing Date: October 25, 2001
Appellant(s): WILEY, JEFFREY G.

Mark D. Trenner, Reg. No. 43,961
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 16, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct except 35 USC § 101 rejection has been dismissed.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,577,907 Czyszczewski et al. 6-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claim 1, 4 – 12, and 14 - 27 rejected under 35 U.S.C. 102(e) as being anticipated by U.S Patent 6,577,907 issued to Joseph Stanley Czyszczewski et al. (hereinafter "Czyszczewski").

Regarding claim 1, Czyszczewski teaches a method for providing access from a multifunction device to an electronic document at a user-specified remote storage device (see column 6, lines 53 – 57 and column 7, lines 12 – 16: Czyszczewski

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discloses accessing multifunction device and documents in electronic format; see also Abstract), comprising:

identifying said user-specified remote storage device having said electronic document based at least in part on a path thereto specified by a user at said multifunction device (see column 3, lines 11 – 17: Czyszczewski discloses remote storage or databases that implements the current invention).

establishing a link between said multifunction device and a user-specified remote storage device having said electronic document (see Fig. 3 and column 3, lines 15 – 20: the connection between the multifunction device and the remote data-store or databases is through common networking interfaces such as Internet or LAN); and

accessing said electronic document at said user-specified remote storage device from said multifunction device over said link established therebetween (see column 3, lines 50 – 51 and column 6, lines 55 – 56: Czyszczewski disclose accessing remote datastores and the datastores contain among other, the electronic document); and

sending said electronic document from said multifunction device (see column 7, lines 19 – 23: the user operates the multifunction device to send the document to the selected destination).

Regarding claim 4, Czyszczewski teaches identifying said user-specified remote storage device is based at least in part on a user profile (see column 3, lines 50 – 55).

Regarding claim 5, Czyszczewski teaches converting a document to electronic format at said multifunction device (see column 6, lines 53 - 59); and

combining said document in electronic format with said electronic document from said user-specified remote storage device (see column 10, lines 59 – 60).

Regarding claim 6, Czyszczewski teaches combining said electronic document from said user-specified remote storage device with an electronic document generated at said multifunction device (see column 10, lines 48 - 609); and

sending said combined electronic documents from said multifunction device to a network destination (see column 7, lines 62 – 65 and column 12, lines 25 – 27).

Regarding claim 7, Czyszczewski teaches accessing an address book operatively associated with said user-specified remote storage device (see column 12, lines 8 – 14).

Regarding claim 8, Czyszczewski teaches identifying a network destination for an electronic document generated at said multifunction device based on data from said address book (see column 14, lines 14 – 20).

Regarding claim 9, Czyszczewski teaches editing an entry in said address book operatively associated with said user-specified remote storage device from said multifunction device (see column 10, 59 - 60).

Regarding claim 10, Czyszczewski teaches configuring said multifunction device before identifying said user-specified remote storage device (see column 3, lines 56 – 60).

Regarding claims 11 and 20, Czyszczewski teaches displaying at least a portion of electronic document from said user-specified remote storage device at said multifunction device (see column 10, lines 21 - 24).

Regarding claim 12, Czyszczewski teaches a method for accessing user-requested data from a configured multifunction device (column 7, lines 12 – 16: Czyszczewski discloses accessing multifunction device and documents in electronic format; see also Abstract), comprising:

identifying a remote storage device having a user-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device (see column 3, lines 11 – 17: Czyszczewski discloses remote storage or databases that implements the current invention).

retrieving said user-requested document from said configured multifunction device (see column 10, lines 21 – 27: (see column 3, lines 11 – 17: Czyszczewski discloses retrieving documents from remote storage using multifunction device).

Regarding claim 14, Czyszczewski teaches identifying said remote storage device is based at least in part on a user profile (see column 3, lines 50 – 55).

Regarding claim 15, Czyszczewski teaches converting a document to electronic format at said configured multifunction device (see column 6, lines 53 - 59); and combining said document in electronic format with said retrieved user-requested document (see column 10, lines 50 - 60).

Regarding claim 16, Czyszczewski teaches combining said retrieved user-requested document with an electronic document generated at said configured multifunction device (see column 10, lines 48 - 60); and

sending said combined electronic document and retrieved user-requested document from said configured multifunction device to a network destination (see column 7, lines 62 – 65 and column 12, lines 25 - 27).

Regarding claim 17, Czyszczewski teaches retrieving user-requested data from an address book operatively associated with said remote storage device (see column 12, lines 8 – 14).

Regarding claim 18, Czyszczewski teaches identifying a network destination for an electronic document generated at said configured multifunction device based on said user-requested data retrieved from said address book (see column 14, lines 14 – 20).

Regarding claim 19, Czyszczewski teaches editing an entry in said address book operatively associated with said remote storage device from said multifunction device (see column 10, lines 59 - 60).

Regarding claim 21, Czyszczewski teaches a multifunction device comprising:
computer-readable media operatively associated with said multifunction device and having computer-readable program code thereon including program code for identifying data operatively associated with a user-specified remote storage device (see column 9, line 60 – column 10, line 3); and

program code for accessing said data operatively associated with said user-specified remote storage device from said multifunction device (see column 10, lines 21 - 26).

Regarding claim 22, Czyszczewski teaches said data is an address book (see column 12, lines 8 – 14).

Regarding claim 23, Czyszczewski teaches program code for retrieving an entry from said address book, said entry identifying a network destination (see column 12, lines 8 – 23);

program code for associating said entry from said address book with an electronic document at said multifunction device (see column 7, lines 14 – 26); and

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program code for sending said electronic document to said network destination identified by said entry from said address book (see column 7, lines 16 – 22).

Regarding claim 24, Czyszczewski teaches said data is a document in electronic format (see column 2, lines 65 – 67).

Regarding claim 25, Czyszczewski teaches program code for sending a document in electronic format from said multifunction device to a network destination (see column 3, lines 1 – 7 and column 7, lines 12 – 25).

Regarding claim 26, Czyszczewski teaches program code for combining a document in electronic format with a document image at said multifunction device (see column 9, lines 3 – 7);

program code for sending said combination of said document in electronic format and said document image from said multifunction device to a network destination (see column 5, lines 30 – 40).

Regarding claim 27, Czyszczewski teaches said user-specified remote device is another multifunction device (see column 7, lines 26 – 40).

(10) Response to Argument

Rejection under 35 U.S.C. § 101

Appellant's argument regarding rejection under 35 USC § 101 of the last Office action is persuasive and, therefore, the rejection under 35 USC § 101 of that action is withdrawn.

Response to Appellant's Argument regarding claims 1, 4 – 12, and 14 – 27 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Czysteczewski

(i) Independent claim 1

Response to appellant's argument that there is no teaching or suggestion of ***"identifying a user-specified remote storage device based at least in path on a part specified by a user"*** as argued on page 8, paragraph 2.

Examiner respectfully disagrees with the appellant. Czysteczewski teaches identifying a user-specified remote storage device based at least in path on a part specified by a user (column 3, lines 30 – 33: – Examiner interprets "the operator can retrieve a document or a form from a local or a remote datastore, and then fax, e-mail, copy and/or print the document on the multifunction device" as "identifying a user-specified remote storage device", It is inherent that when a document is retrieved from a remote datastore, the device has to be specified before retrieving the document from the device; it is also inherent that a path is specified when a document is faxed or

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emailed from the multifunction device either by the fax number or email address of the device/site. Also Czyszczewski discloses at column 10, lines 25 – 26 “the user can retrieve a document from a remote datastore 150 and fax, e-mail or print it on a selected device”; Again it is inherent that when a document is retrieved from a remote datastore by a user, the device has to be specified by the user before retrieving the document; it is also inherent that a path is specified when a document is faxed, printed or emailed from the multifunction device either by the fax number, print directory/path as shown on Fig. 3 steps 53 and 55 or email address of the device or site. These disclosures of Czyszczewski fairly suggest applicant’s claimed invention of identifying a user-specified remote storage device based at least in part on a part specified by a user.

(ii) Dependent claims 4, 7 - 11

Examiner respectfully traverses the presumptions of the appellants that claims 4, 7 - 11 are allowable as argued on page 9. Examiner rejected these claims as declared in section **(9) Grounds of Rejection** above. Since claims 4, 7 - 11 depend from claim 1 and for at least the response to argument (i) above which addresses this argument and also applicable herewith, examiner submits that these rejections should be sustained.

(iii) Dependent claim 5

Examiner respectfully traverses the presumptions of the appellants that claim 5 is allowable as argued on page 9.

Response to appellant's argument that there is no teaching or suggestion that ***"an electronic document from the user-specified remote storage device is combined with a document converted to an electronic format at the multifunction device"*** as argued on page 9, paragraph 4.

Examiner respectfully disagrees with appellant's argument regarding claim 5.

Examiner submits that Czyszczewski teaches converting a document to electronic format at said multifunction device (column 6, lines 53 – 59; Examiner interprets "commonly used documents in electronic format" as "converting a document to electronic format"). Please refer to response to argument (i) on which the Examiner explains that Czyszczewski discloses ***"the user-specified remote storage device"*** which is applicable herewith.

Examiner interprets Czyszczewski's teaching of "the multifunction device 10 may also check the website periodically to ensure that it has a current list of document" at column 6, lines 53 - 59 as "combining said document in electronic format with said electronic document from said user-specified remote storage device" as stated in claim 5. Examiner rejected this claim as declared in section ***(9) Grounds of Rejection*** above. Since claim 5 depends from claim 1 and for at least the response to argument (i) above, examiner submits that these rejections should be sustained.

(iv) Dependent claim 6

Examiner respectfully traverses the presumptions of the appellants that claim 6 is allowable as argued on page 9.

Response to appellant's argument that there is no teaching or suggestion that ***"an electronic document from the user-specified remote storage device is combined with a document converted to an electronic format at the multifunction device"*** as argued on page 9, paragraph 4.

Examiner respectfully disagrees with appellant's argument regarding claim 6.

Please refer to response to arguments (i) and (iii) above which address this argument and also applicable herewith. Examiner rejected this claim as declared in section **(9) Grounds of Rejection** above. Since claim 6 depends from claim 1 and for at least the response to argument (i) above, examiner submits that these rejections should be sustained.

(v) Independent claim 12

Response to appellant's argument that Citations of Czyszczewski fail to teach or suggest of ***"identifying remote storage device having a user-requested document based at least in part on a path for said remote storage device specified by a user at said configured multifunction device"*** as argued on page 11, paragraph 2.

Examiner respectfully disagrees with appellant's argument. Please refer to the response to appellant's argument (i) above which is addresses this argument and also applicable herewith. In addition, Czyszczewski teaches a "configurable

multifunction device” as shown at column 10, lines 43 – 47. Examiner rejected this claim as declared in section **(9) Grounds of Rejection** above. For at least the response to argument (i) above, examiner submits that these rejections should be sustained.

(vi) Dependent claims 14 and 17 - 20

Examiner respectfully traverses the presumptions of the appellant that claims 14 and 17 - 20 are allowable as argued on page 11. Examiner rejected these claims as declared in section **(9) Grounds of Rejection** above. Since claims 14 and 17 - 20 depend from claim 12 and for at least the response to arguments (i) and (v) above which address this argument and also applicable herewith, examiner submits that these rejections should be sustained.

(vii) Dependent claim 15

Examiner respectfully traverses the presumptions of the appellant that claim 15 is allowable as argued on page 11. Examiner rejected these claims as declared in section **(9) Grounds of Rejection** above. Since claim 15 depends from claim 12 and for at least the response to arguments (i), (iii) and (v) above which address this argument and also applicable herewith, examiner submits that these rejections should be sustained.

(viii) Dependent claim 16

Examiner respectfully traverses the presumptions of the appellant that claim 16 is allowable as argued on page 11. Examiner rejected these claims as declared in section **(9) Grounds of Rejection** above. Since claim 16 depends from claim 12 and for at least the response to arguments (i), (iv) and (v) above which address this argument and also applicable herewith, examiner submits that these rejections should be sustained.

(ix) Independent claim 21

Response to appellant's argument that Czyszczewski fails to disclose a user-specified remote storage device as argued on page 12, paragraph 2.

Examiner respectfully disagrees with applicant's argument. Claim 21 is computer-readable program code which recites similar limitations as claim 1. Therefore, refer to the response to appellant's argument of Claim 1 above that addresses this argument and also applicable herewith. Examiner rejected this claim as declared in section **(9) Grounds of Rejection** above. For at least the response to argument (i) above, examiner submits that these rejections should be sustained.

(x) Dependent claims 22 – 25 and 27

Examiner respectfully traverses the presumptions of the appellant that claims 22 – 25 and 27 are allowable as argued on page 13. Examiner rejected these claims as declared in section **(9) Grounds of Rejection** above. Since claims 22 – 25 and 27 depend from claim 21 and for at least the response to arguments (i) and (ix) above

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which address this argument and also applicable herewith, examiner submits that these rejections should be sustained.

(xi) Dependent claim 26

Examiner respectfully traverses the presumptions of the appellant that claims 26 is allowable as argued on page 13. Examiner rejected these claims as declared in section **(9) Grounds of Rejection** above. Since claim 26 depends from claim 21 and for at least the response to arguments (i), (iii) and (ix) above which address this argument and also applicable herewith., examiner submits that these rejections should be sustained.

For the above reasons, it is believed that the rejections should be sustained.

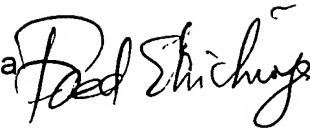
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Respectfully submitted,

Examiner Fred Ehichioya

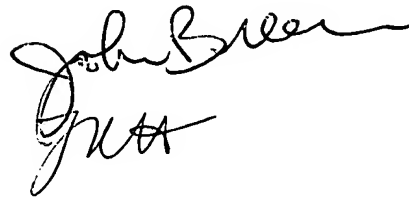
February 1, 2006



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